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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,876	08/18/2006	Jordi Tormo i Blasco	5000-0192PUS1	2828

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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MURRAY, JEFFREY H

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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09/04/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,876	<b>Applicant(s)</b> BLASCO ET AL.	
	<b>Examiner</b> JEFFREY H. MURRAY	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-5 and 8 were rejected in the previous action.
2. Claims 1-5 and 8 are pending in this application. Claims 6, 7, 9 and 10 have been withdrawn. This action is in response to the applicants' amendment after a non-final and reply filed on May 30, 2008.

### ***Withdrawn Rejections/Objections:***

3. Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

### ***Double Patenting***

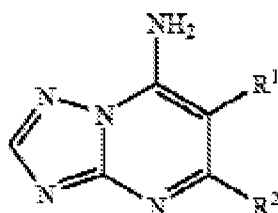
4. Claims 1-5 and 8 are provisionally rejected on the ground of obviousness type double patenting as being unpatentable over claim 1 of U.S. Patent Publication No. 2007/0179061 and U.S. Patent Publication No. 2007/0173408.

Applicants have asked that the double patenting rejections be held in abeyance until one of the above patent applications grants as a patent. The examiner cannot hold the application in abeyance until "other" applications potentially grant, but can hold the rejection of the current application in abeyance until the "current application" contains allowable subject matter and is ready to be granted allowability.

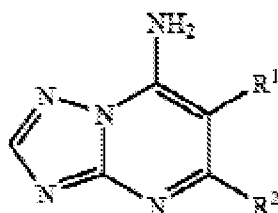
Second, the applicants have argued that it is insufficient to allege obviousness based on the assertion that the chemical structures are homologs. They argue the unpredictability of the structure and properties of the compounds makes does not allow

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for a suggestion to one skilled in the art to make and test the claimed compounds. This argument is found unpersuasive. In the current rejection, both applications recite a compound of the following formula:

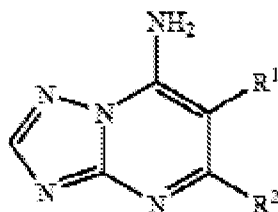


Where  $R_1$  can be a  $C_5$ - $C_{12}$ -alkyl and  $R^2$  can be either an ethyl group or a  $C_5$ - $C_{12}$  alkyl. In the current application the compound claimed is a compound of the following formula:



Where  $R_1$  can be a  $C_5$ - $C_9$ -alkyl and  $R^2$  can be an *n*-propyl or *n*-butyl group. These groups clearly are homologs of each other as stated in the previous action. The basis for a suggestion to make them is explicitly clear within each application. All three applications are used for the same purpose, to make 5,6-dialkyl-triazolopyrimidines for the purpose of using them to control phytopathogenic fungi. This can be seen in the abstracts and brief summary sections in all three applications.

In addition, one does not need to look far for determining proper motivation. Both the '061 and '408 applications teach a triazolopyrimidine of the formula:



Where  $R^1$  is a  $C_5$ - $C_{12}$  alkyl group, which encompasses the  $C_5$ - $C_9$  group claimed in the current application. Where the three applications differ is at the  $R_2$  position. The '061 application teaches where  $R^2$  is  $C_5$ - $C_9$  alkyl. The '408 patent application teaches where  $R^2$  is an ethyl group (or an unsubstituted  $C_2$  alkyl group). Therefore, in looking at the prior art, it teaches compounds useful for controlling phytopathogenic fungi where the  $R_2$  group can be a  $C_2$  or  $C_5$ - $C_{12}$  alkyl group, and barring a strict teaching away, it is only natural for a one skilled in the art to think that the  $C_3$  and  $C_4$  groups which fall in between these two applications would also be active for the same purpose. Thus, one skilled in the art would have proper motivation to try and make a triazolopyrimidine with a  $C_3$ - $C_4$  alkyl group for  $R^2$ . The applicants' arguments have not been found persuasive.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome a provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

These remain provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

***Conclusion***

5. Claims 1-5 and 8 are rejected.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Patent Examiner  
Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**